

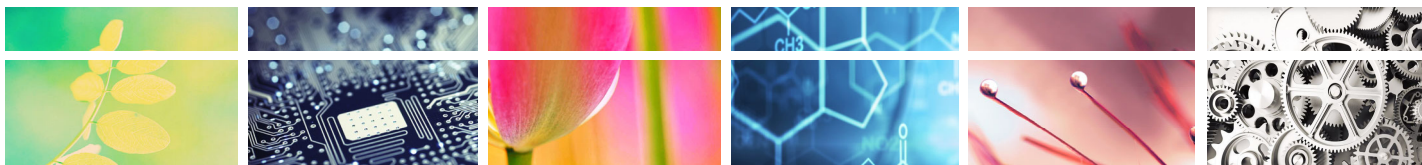
Jornadas de estudio y actualización en materia de patentes "Los Lunes de Patentes"

Studying & Updating Days on Patent Issues "The Patent Mondays"

Barcelona

Lunes, 18 de marzo de 2024

Monday, 18 March 2024



UNIVERSITAT DE BARCELONA

Centre de Patents



MINISTERIO DE INDUSTRIA Y TURISMO



Oficina Española de Patentes y Marcas

Objetivos

Que sean útiles para los que, con mayor o menor experiencia, ya llevan algún tiempo trabajando profesionalmente en España sobre temas relacionados con patentes o modelos de utilidad. Son personas que tienen distintas formaciones iniciales (técnica, jurídica, económica, gestión...) y han trabajado en ámbitos laborables muy variados (particular, empresa, agencia, bufete, enseñanza, oficina de patentes,...). Todos ellos tienen interés en temas sobre patentabilidad, infracción, procedimientos, etc, principalmente en España, pero también en la EPO, EEUU, China, Japón y otros países. Algunos de ellos se presentarán al examen para ser agente de la propiedad industrial español.

Que sean útiles como ayuda para los que piensan presentarse al *European Qualifying Examination* de la EPO, con intención de adquirir el título de European Patent Attorney. Esto implica que los temas del Convenio de la Patente Europea y del PCT se tratan al máximo nivel.

Que sean útiles para los menos expertos, o incluso principiantes, que desean formarse en materia de patentes.

Que sean útiles a todos para actualizar los conocimientos (p. ej. en legislación y jurisprudencia), pues el mundo de las patentes está en constante cambio y resulta difícil mantenerse al día. Y que sean útiles para conocerse y estar en contacto los relativamente pocos que trabajan profesionalmente en este tema.

Foro de aprendizaje y discusión

Las Jornadas de estudio y actualización en materia de patentes ("Los Lunes de Patentes") son un foro de aprendizaje y discusión, totalmente *pro bono* (los asistentes no pagan, los ponentes no cobran, ni siquiera gastos), profesional y abierto a todas las opiniones. Desde comienzos de 2001, cuatro lunes al año se reúnen personas interesadas en formarse sobre patentes (incluyendo modelos de utilidad y *know-how*) desde un punto de vista profesional, independientemente de su especialidad y del lugar de trabajo.

Funcionamiento

Es totalmente *pro bono* para ponentes y asistentes. Dado que el aforo es limitado, hay que inscribirse con antelación y recibir confirmación de la inscripción. El local lo proporciona la OEPM o el Centro de Patentes de la UB. Y la documentación, que suele ser voluminosa, se distribuye por correo electrónico y colgándola en la página web: www.ub.edu/centredepatents.

Objectives

The main objective of these workshops is to be useful for those who, with more or less experience, work professionally in Spain on issues related to patents or utility models. They are people who have different initial backgrounds (technical, legal, economic, management ...) and have worked in many different business areas (private, company, agency, law firm, teaching, patent office, ...). All of them are interested in issues of patentability, infringement, procedures, etc., mainly in Spain, but also in EPO, USA, China, Japan and other countries. Some of them will take the exam to become a Spanish industrial property agent.

Another objective is to be helpful to those who want to take the EPO European Qualifying Examination with the intention of obtaining the title of European Patent Attorney. This means that all the European Patent Convention and the PCT issues are covered at the highest level.

They are also meant to be useful for the least experts, or even beginners, who wish to be trained in the field of patents.

They also try to be useful to everyone to update knowledge (e.g. in legislation and case law), as the world of patents is constantly changing and it is difficult to keep up to date.

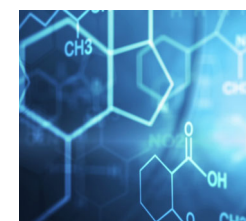
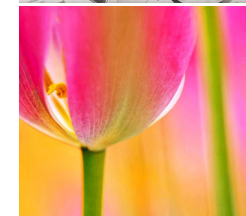
Finally, these workshops aim at becoming a meeting point for the relatively few professionals working on patents.

Learning and discussion forum

The Studying & Updating Days on Patent Issues ("The Patent Mondays") are a fully pro bono (attendants do not pay, speakers are not paid, even for expenses), professional and to-all-opinions open forum for learning and discussion. Since the beginning of 2001, regardless of their specialty and workplace, people interested in training on patents (including utility models and know-how) from a professional point of view, gather four times a year.

How it works

It is fully pro bono for speakers and attendants. Given the limited capacity, registration and its confirmation are needed. Premises are provided by the OEPM or the Patent Centre of the UB. And documentation, which is usually voluminous, is distributed by e-mail and can also be downloaded from the website: www.ub.edu/centredepatents.



Dr. David Loretto

With a background of B.Sc. in physics, Ph.D. in materials science and engineering, and J.D. (Juris Doctor), David became U.S. Patent Attorney and U.S. Attorney-at-Law. He has more than twenty years of experience working in patent law, before which he applied electron microscopy to semiconductor materials at industrial, government and university laboratories, principally in the U.S. After graduating from law school in New York, in 2002, he clerked for Judge (now Associate Justice) Samuel A. Alito, Jr. at the U.S. Court of Appeals for the Third Circuit in Newark, New Jersey, and has since held positions at major U.S. and European firms, where he has worked on U.S. patent litigation, U.S. and international patent prosecution, and providing opinions on non-infringement and invalidity of U.S. patents. He works now at the consultancy firm **aera** in Madrid.



Divided Infringement of U.S. Patents: Risks and Opportunities

Though liability for U.S. patent infringement usually involves finding a single entity responsible for directly infringing a patent, multiple entities can also be found responsible for direct infringement, where one of the entities "directs" or "controls" the performance of the others or where the entities form a joint enterprise. *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, 797 F.3d 1020, 1022 (Fed. Cir. 2015) (en banc).

Such "divided infringement" can occur for any claim that covers actions by multiple entities, especially when they act at multiple locations. (For example, the passenger luggage locks adapted to be openable by security staff in *Travel Sentry, Inc. v. Tropp*, 877 F. 3d 1370 (Fed. Cir. 2017)).

All else being equal, the likelihood of such "divided infringement" is greater for high-tech and biopharmaceutical inventions, for which the claims are more likely to fall into one or both of the following categories:

- Networked inventions, which necessarily involve communication between separate entities. (For example, the content delivery networks in *Akamai v. Limelight*).
- Inventions that include one or more of the judicially created exceptions to patent eligible subject matter - "abstract ideas", "laws of nature" or "natural phenomena"- which, under the *Alice-Mayo* framework applied at the USPTO, must add "something more" to be patent eligible. (For example, a patent-ineligible diagnostic test that adds a patent-eligible treatment step).

The USPTO, naturally, focuses on validity, and has no responsibility to consider how many entities would be required to infringe a granted claim, an issue which is left to U.S. courts and, on occasion, the U.S. International Trade Commission, to resolve. For many granted claims, for which infringement requires the actions of multiple entities, establishing divided infringement may be difficult, or even impossible.

An understanding of how divided infringement has been applied in U.S. courts can thus be of value to patent owners and potential infringers alike. Examples will be discussed.

Johannes Heselberger

Johannes is Graduate Physicist, Attorney-at-Law (Rechtsanwalt, since 1994), European Patent Attorney (since 1999), and UPC Representative. He is partner of **BARDEHLE PAGENBERG**. He has comprehensive technical experience in the field of telecommunications, medical devices, and the automotive industry. He has a comprehensive professional expertise in SEP and FRAND litigations as well as in enforcement of and defense against license programs. Pharmaceutical and biotech cases are also part of his field of practice. Johannes represents clients in patent infringement and nullity proceedings before German courts as well as before the UPC. He is currently representing clients in various pending UPC proceedings.



Dr. Ronja Schregle

Ronja is Attorney-at-Law (Rechtsanwältin) and UPC Representative. Her practice focuses on patent and trade secret litigation. She has technical experience in the field of telecommunications, mechanical engineering, and video coding. Prior to joining **BARDEHLE PAGENBERG** in 2021, Ronja worked in research and teaching at the Chair of Corporate and Intellectual Property Law at the Technical University of Munich. Ronja is currently representing clients in various cases pending at the UPC and is one of the authors of the UPC Judge's commentary to be published at the end of 2024. She advises clients in German, English, and Spanish.



First experiences at the Unified Patent Court

As soon as the Unified Patent Court opened its doors on June 1, 2023, Johannes and Ronja filed an infringement action for one of their clients. As of February 1, 2024, **BARDEHLE PAGENBERG**'s patent litigation team handles 62 UPC cases, including 23 counterclaims. In the meantime, **BARDEHLE PAGENBERG** has represented clients in oral hearings before the Local and Central Divisions and the Court of Appeal. Johannes and Ronja will let listeners in on their first-hand practical experiences at the UPC. Topics will have a strong practical focus and include:

1. The Case Management System (CMS)
2. Service of the Statement of Claim
3. How are deadlines handled at the UPC?
4. Oral hearings
5. Language of the Proceedings

Luis Rodríguez Vega

Luis es actualmente magistrado de la Sección 15ª, de lo Mercantil, de la Audiencia Provincial de Barcelona. En 1989 ingresó en la carrera judicial y desde 1991 ha ejercido como juez en Cataluña. Desde su creación hasta 2015 fue magistrado titular del Juzgado de lo Mercantil nº 4 de Barcelona, uno de los tres a los que se les atribuye el conocimiento, con carácter exclusivo, de los asuntos relativos a patentes en Cataluña. Ha recibido la medalla de honor de la Generalitat por servicios excepcionales a la justicia, y la Cruz de San Raimundo de Peñafort.



El recurso de apelación en materia de patentes, visto por un juez de segunda instancia: *please don't shoot at the judge of first instance; he is doing his best*

- El objeto del recurso de apelación no es la sentencia de primera instancia.
- El derecho a un nuevo pronunciamiento sobre las pretensiones de las partes no consentidas.
- Las pretensiones de las partes.
- La redacción del recurso.
- La utilidad de la vista en segunda instancia.
- La función del juez de segunda instancia.

Lugar

Auditori Antoni Caparrós
Parc Científic de Barcelona
Baldiri Reixac 4
08028 Barcelona

Horario

De 10:00 a 13:00 h y de 15:00 a 18:00 h

Documentación

Se distribuye por correo electrónico y se puede descargar de la web del Centre de Patents.

www.ub.edu/centrepatents

Inscripción

Inscripción gratuita. Enviar correo a nuriasans@ub.edu proporcionando nº de DNI y nombre completo, tal como aparece en el DNI, y esperar confirmación de la inscripción.

Lista de distribución

Las jornadas se convocan a través de una lista de distribución. Para ser añadido a esta lista, enviar nombre, institución y dirección de correo electrónico al coordinador: pascualsegura@ateneu.ub.edu

Notas

Los organizadores se reservan el derecho de cancelar esta jornada o modificar cualquier aspecto relacionado. Asimismo, no se responsabilizan de las opiniones expresadas por los ponentes.

Venue

Auditori Antoni Caparrós
Parc Científic de Barcelona
Baldiri Reixac 4
08028 Barcelona

Time

From 10:00 to 13:00 h and from 15:00 to 18:00 h

Material

It is distributed by e-mail and it can also be downloaded from the Patent Centre website.

www.ub.edu/centrepatents

Registration

Free of charge. Send e-mail to nuriasans@ub.edu providing ID number and full name, as it appears on the ID document, and wait for confirmation.

Distribution list

Workshops are announced through a distribution list. To be added to this list please send name, institution, and e-mail address to the coordinator: pascualsegura@ateneu.ub.edu

Notes

The organizers reserve the right to cancel this workshop or to modify any aspect thereof. In addition, they will not be responsible for the opinions expressed by the speakers.

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